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ROBERT RYAN MORISHITA
MORISHITA LAW FIRM, LLC
3800 HOWARD HUGHES PKWY,
SUITE 850
LAS VEGAS, NV 89169

EXAMINER	
HOEL, MATTHEW D	
ART UNIT	**PAPER NUMBER**
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/942,520	ODOM, WAYNE	
	Examiner	Art Unit	
	Matthew D. Hoel	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7,8,12 and 14-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7,8,12 and 14-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7, 8, 12, and 14 to 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Claim 15 cites: "prior to play of the next hand displaying the number of each indicia remaining in each indicia set in the inventory as depleted and displaying any winning outcomes eliminated as a result of depletion of said indicia inventory." This limitation appears to be enabled by Page 10, Lines 15 to 28; Page 12, Lines 13 and 14; and item 118, Fig. 4. The specification does not directly display to the player winning outcomes eliminated as a result of inventory depletion. In fact the specification says: "Thus as games are played the player can assess the constituency of the remaining inventory." (Page 10, Lines 26 and 27). The player must deduce which winning outcomes have been eliminated by viewing which indicia remain in the inventory. The exact winning outcomes remaining are not directly displayed to the player. A winning outcome no longer available is only directly displayed at the particular time it is dealt

and awarded to the player, but nowhere does the specification cite cumulatively displaying eliminated winning outcomes to the player, which is what the claims appear to be claiming. This limitation is essentially a negative limitation without adequate support in the specification (MPEP 2173.05(i)). The examiner notes that Figs. 1 and 2 and Page 6 show the original balance of indicia in the shoe and the remaining balance of the respective indicia in the shoe. The outcomes are based on combinations of indicia, not just individual indicia. The combinations are three Blue 7s, 3 Red 7s, Mixed 7s, three Triple Bars, three Double Bars, three Single Bars, Mixed Bars, and three Blanks. It is thus hard for the player to know how many winning outcomes or winning combinations of indicia exist since it is the remaining indicia and not necessarily combinations of indicia that are displayed to the player. Neither is adequate support found in the provisional, 60/229,665. The examiner suggests that the applicants rewrite this limitation to more clearly cite what is in the specification.

4. Claim 19 cites: "said processor configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure, to issue an award for each selected and displayed winning outcome, to control the display to display prior to the play of the next hand data corresponding to the remaining inventory of indicia sets depleted of said displayed game indicia including the display of data corresponding to the depletion of indicia from said inventory such that one or more scheduled winning outcomes are unavailable due to depletion and said processor configured to, for the next hand of play, select indicia from the depleted inventory." This claim is rejected for the same reasons as Claim 15.

5. Claim 23 cites: “prior to the commencement of the next hand of play displaying to the player information regarding any winning outcomes eliminated by said depletion of indicia". This claim is rejected for the same reasons as Claim 15.

6. Claim 24 cites: “prior to play of the next hand displaying to the player any winning outcomes eliminated by depletion of the indicia and the number of each indicia remaining in each indicia set in the inventory as depleted of the prior selected and displayed inventory". This claim is rejected for the same reasons as Claim 15.

7. Claim 25 cites: “prior to play of a subsequent hand, displaying the number of each indicia remaining in the sets in the inventory as depleted of the prior selected and displayed inventory and any winning outcomes eliminated as a result of depletion". This claim is rejected for the same reasons as Claim 15.

8. Claim 26 cites: “said processor configured to compare said outcome to a schedule of winning outcomes stored in a data structure, to issue an award for a winning combination and to control a display to display prior to play of the next hand any scheduled winning outcomes eliminated by depletion of said indicia". this claim is rejected for the same reasons as Claim 15.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 26 to 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 26 recites the limitation "play of the next hand" in the thirteenth line. There is insufficient antecedent basis for this limitation in the claim. The examiner believes the applicants intend to cite “the next play of the game” which would have antecedent basis in “play of the game” as cite in the sixth line.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 23 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/007,108 in view of “Scarne’s Encyclopedia of Card Games,” by John Scarne, 1961, HarperCollins (chapter on Poker), entered as NPL on 8-10-2007. Claim 1 of ‘108 claims a method for conducting a wagering game using an inventory of indicia, the inventory when fully constituted having X number of individual indicia: “a method for conducting a

wagering game for a player in accordance with the rules of a base game defining a winning hand, comprising: defining a finite set of game indicia". Claim 1 of '108 claims receiving a wager from a player to play a series of hands: "(a) receiving a wager from said player; (b) dealing game indicia to said player from said finite set cumulatively excluding all game indicia dealt in previous hands, if any". Claim 1 of '108 claims for each hand of play selecting and displaying a plurality of individual indicia from the inventory, the combination of individual indicia selected and displayed defining a winning or losing outcome for the hand and depleting said displayed individual indicia from the inventory available for play of the next hand: "(b) dealing game indicia to said player from said finite set cumulatively excluding all game indicia dealt in previous game hands, if any; (c) conducting said game hand for said player to completion according to said base game and resolving said wager based at least in part on whether said game forms a winning hand". Claim 1 of '108 claims for a winning outcome, issuing an award to a player: "(c) conducting said game hand for said player to completion according to said base game and resolving said wager based at least in part on whether said game forms a winning hand". Claim 1 of '108 claims prior to the commencement of the next hand of play displaying to the player information regarding any winning outcomes eliminated by said depletion of indicia: "(e) displaying at least one of: the inventory of said game indicia from said finite set cumulatively excluding all game indicia dealt in previous game hands or winning hands eliminated as a result of said excluded game indicia; conducting at least one additional sequential game hand". Claim 1 of '108 claims the player making another wager to play a hand using the depleted inventory:

"conducting a game hand for said player comprising: (a) receiving a wager from said player" ... "conducting at least one additional sequential game hand of steps (a)-(e)". Claim 1 of '108 does not claim the random selecting and dealing. The random selecting and dealing, however, is disclosed in Scarne's chapter concerning poker (Pages 6 to 18, particularly shuffle, cut, and deal on Pages 12 and 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the random selection and dealing of Scarne's poker embodiment to the claimed invention of '108 Claim 1. '108 states on Page 1 of the specification that it is specifically intended to be used with poker, among other games. One of the effects of Claim 1 of '108 would be to prevent the players from knowing what indicia (cards, in this case) remain in the deck as the cards are claimed as being collected from the player after the hand and excluded from further play. The shuffling if done in an honest manner would have the effect and advantage of making cheating more difficult as none of the players would know what order the cards are in the deck. This advantage is also suggested by Page 13 of Scarne's poker embodiment as a player is able to ask for a new shuffle and cut if he or she does not like how the cards have been cut before the start of the deal. This is a provisional obviousness-type double patenting rejection.

Response to Arguments

14. Applicant's arguments, see brief, filed 11-21-2007, with respect to Claims 7, 8, 12, and 14 to 18 have been fully considered and are persuasive. The rejections of 8-10-2007 have been withdrawn. Upon review and consultation, the examiner finds no

suggestion in the prior art of eliminated outcomes displayed over hand-to-hand play of a game. See for example Page 9 of the Board's decision on 8-5-2005 (appeal no. 2005-1071) in formerly co-pending case 09/977,138 (now U.S. patent 7,056,205 B2). The Board interpreted Fuchs as being clear that Fuchs was using the term game to include the deal of cards within a hand of poker, which would preclude the claimed hand-to-hand play. The claims are allowable over the art of record. Only minor 112 issues and double patenting issues need to be resolved.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The applicant in U.S. patent publications 2005/0143158 A1; 2002/0155872 A1; 2002/0103017 A1; and 7,056,205 B2 teach similar methods.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571)272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel
Patent Examiner
AU 3714

/Robert E. Pezzuto/
Supervisory Patent Examiner
Art Unit 3714

/M. D. H./
Examiner, Art Unit 3714